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09/684,828	10/10/2000	Teresa Farias Latter	8285/397	6942

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EXAMINER
FOSTER, ROLAND G

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/684,828	Applicant(s) LATTER ET AL.	
	Examiner Roland G. Foster	Art Unit 2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 October 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested as is consistent with the certificate of correction submitted for the patent issuing from the parent application: Method and System for Providing Enhanced Caller Identification Screening Using Audible Caller Name Announcement.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 11-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,178,232 B1 (Latter et al.) ("Latter"). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the continuation are broader than the claims in the patent, *In re* Van Ornum and Stang, 214 USPQT61, broad claims in continuation applications are rejected as obvious double patenting over previously patented narrow claims. For example, claim 11 of the present invention is the same as claim 1 of the patent except that no call is automatically cancelled if the calling party does not provide audible caller identification information. Therefore, claim 11 of the present invention is broader than claim 11 of the patent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the

United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 11-13, 15, 17-21, 24, and 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Devillier (U.S. Patent No. 5,850,435) (Hereinafter "Devillier").

Summary

Devillier discloses a method for providing audible caller identification. The method steps of Fig. 1 outside the dashed box are common to all embodiments of Devillier. The method of Fig. 3 illustrates a different embodiment that replaces the dashed box embodiment of Fig. 1. The embodiment illustrated by Fig. 3 will be relied upon in this office action.

With respect to claim 11, see the following paragraphs for details on how Devillier anticipates particular limitations within the claim.

"(a) determining whether standard caller identification information for the calling communication station can be provided to the called communication station by analyzing data contained within a query" reads on Devillier as follows. The system determines whether the caller's name (standard caller

identification) can be provided by querying a line information database (Fig. 3, step 301 and col. 3, line 65 - col. 14). The database "query" contains "data" in the form of the caller's number. The caller's number (data within the query) is analyzed in order to determine whether the caller's name (standard caller identification information) can be retrieved from the database and provided to the called station. Therefore, the system analyzes data (caller's number) contained within the query to determine whether the standard caller identification information (caller's name) can be provided.

"(b) transmitting a request for audible caller identification information to the calling communication station in response to a determination that the standard caller identification information cannot be provided to the called communication station" clearly reads on Fig. 3, steps 303, 305, and col. 4, lines 7-8.

"(c) transmitting the audible caller identification information to the called communication station if the calling party provides audible caller identification information" clearly reads on Fig. 1, step 117 and col. 3, lines 21-22.

Claim 24 differs substantively from claim 11 in that claim 24 recites the following additional limitations. "(c) receiving audible caller identification information from the calling party" clearly reads on Fig. 1, step 111. "(d) causing the called communication station to ring" reads on Fig. 1, step 115 and col. 3, lines 13-21 where the system causes a call to be placed to a telephone. The ring can be in the form of a conventional ring or audible caller name announcement (col. 3, lines 33-36).

With respect to claims 12 and 13, see col. 4, lines 5-8 where a null or invalid calling name would be an unavailable or incomplete.

With respect to claim 15, see Fig .1, step 109 and col. 2, line 65 - col. 3, line 3.

With respect to claim 17, see Fig. 1, steps 111 and 117.

With respect to claims 18, 19, 26, and 27, see Fig. 1, step 119.

With respect to claim 20, see col. 3, lines 37-40.

With respect to claims 21 and 28, see Fig .1, step (121).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 14, 16, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Devillier as applied to claims 11 and 24 above, and further in view of Blumhardt (U.S. Patent No. 5,533,106) (Hereinafter "Blumhardt").

With respect to claim 14, although Devillier discloses the step of determining if a null or otherwise invalid caller identification is detected (col. 4, lines 5-8), Devillier does not specifically disclose determining if a caller identification has been blocked.

However, Blumhardt also teaches of an caller identification method (Fig. 5) that includes the step of determining if the caller identification has been blocked (col. 3, lines 9-15).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the step of determining whether caller identification has been blocked as taught by Blumhardt to the audible caller identification system disclosed by Devillier.

The suggestion/motivation for doing so would have been to increase the user-friendliness of a caller identification system

by reducing the readily known ability of the most undesirable callers to select the "privacy" option and block the transmission of their DN that would in many cases defeat the objectives of caller identification (Blumhardt, col. 2, lines 14-32).

With respect to claims 16 and 25, Devillier discloses that step of repeatedly transmitting a request for the calling party to speak his name (Fig. 3, step 305) until a valid name is received or until a system error limit is reached such as three attempts (Fig. 1, step 113 and col. 3, lines 5-13). Devillier does not expressly disclose that message indicates that the called station does not accept calls from an unidentified calling party.

However, Blumhardt also teaches of a caller identification method (Fig. 5) that includes the step of indicating that the called station does not accept calls from an unidentified calling party (play announcement for caller..."to be connected to your party, you must allow your 'calling party ID' to be displayed'...").

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the step of indicating that the called station does not accept calls from an unidentified calling party as taught by caller identification method of Blumhardt to the caller identification method disclosed by Devillier.

The suggestion/motivation for doing so would have been to increase the user-friendliness and versatility of the caller identification system by making it clear to the caller that identification is required. This much is suggested in Devillier by the repeated prompting of the caller to enter an identification until a valid identification is received or until a system error limit is reached (e.g., three attempts) as discussed above. Further, indicating that identification is required upfront by a single, express statement, as taught by Blumhardt, instead of indicating that identification is required by repeatedly prompting the caller (e.g., three attempts) would have increased efficiency by simply avoiding the need for repeated, time-consuming and resource consuming prompting. Finally, the particular indications that the prompt disclosed by Devillier actually provide to the caller reads on message content, and as such, does not require Devillier to be

substantially modified in a structural sense. The claimed invention should result in a significant structural difference over the prior art in order to patentably distinguish the claimed invention from the prior art. In this way, owners of the patented prior art devices are protected when using their devices as they see fit.

Claims 22 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Devillier as applied to claims 11 and 24 above, and further in view of Newton (Harry Newton, Newton's Telecom Dictionary, 8th Ed., ISBN 0-936648-60-0) (Hereinafter "Newton").

Devillier discloses that the calling communication telephone may be connected to the called communication telephone in response to the called station "pressing 1" (col. 3, lines 37-42), Devillier does not disclose that the "1" corresponds to a DTMF button.

Newton teaches that telephones contain DTMF signaling buttons (i.e. touchtone) (page 1051, "Touchtone").

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add DTMF signaling buttons as taught by Newton to the method using a called telephone disclosed by Devillier.

The suggestion/motivation for doing so would have been to conform to industry standards since touchtone telephones are extremely well-known and common.

Claims 23 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Devillier as applied to claims 11 and 24 above, and further in view of Serbetcioglu et al. (U.S. Patent No. 5,511,111) (Hereinafter "Serbetcioglu").

Devillier does not disclose the step of canceling the call in response to the called communication station being placed on-hook.

However, Serbetcioglu also teaches of an audible caller identification method (Figs. 2A and 2B) where the call is cancelled if it is detected that the called communication station was placed on-hook (Fig. 2C, step 250). See also col. 9, lines 41-45.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the step of canceling the call in response to the called communication station being placed on-hook as taught by Serbetcioglu to the audible caller identification method by Devillier.

The suggestion/motivation for doing so would have been to conform to industry standards of canceling a service if the called party (subscriber) goes on-hook, or in other words, hangs up. Not canceling service delivery to the subscriber after the subscriber hangs up could be extremely inconvenient and irritating to the subscriber. Finally, since both Devillier and Serbetcioglu are specifically directed to audible caller identification systems, it would be reasonable to conclude that the designer of an audible caller identification system would be aware of the concept and advantages of canceling service delivery if the called party (subscriber) hangs up.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland Foster whose telephone number is (703) 305-1491. The examiner can normally be reached on Monday through Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang, can be reached on (703) 305-4895. The fax phone number for this group is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306-0377.

Roland G. Foster
Patent Examiner
March 24, 2003